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EXAMINER

SOTOMAYOR, JOHN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/875,135

Applicant(s)

ITO, KIJU

Examiner

John L Sotomayor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. In response to the amendment filed August 13, 2003 claims 1-22 are pending.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

#### **[Technological Arts Analysis]**

For a claimed invention to be statutory, the claimed invention must be directed to a practical application within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claims 1-4,7 and 9-15 are clearly directed to a practical application within the technological arts by virtue of the use of a processor and storage in a memory device within the apparatus recited. Claims 5-6 and 16-21, however, are directed solely to the manipulation of abstract ideas involving no practical application within the technological arts.

**[Useful, concrete and Tangible Analysis]**

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. See, e.g., *State Street Bank and Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed Cir. 1994). See also *In re Schrader*, 22 F.3d 290, 297-98, 30 USPQ2d 1445, 1461-62 (Fed. Cir. 1994).

In the present case, the claims do not produce a concrete result. The claims recite a system, method, and program “for selecting factors reliably contributing to enhance target people’s will to achieve results from a plurality of candidates of factors in a case where the calculated correlation coefficient is equal to or larger than a reference value.” One of ordinary skill in the art would not be able to arrive at a specific, repeatable end result for reliably enhancing target people’s will to achieve results to any task as claimed without undue experimentation. This statement is evidenced by the subjective nature of attempts to reliably change a target person’s will to achieve a result. Although numerical evaluation factors are chosen, as claimed, and used as a baseline against which to compare a target person’s responses to questions, the evaluation number itself is arrived at subjectively and may not represent any or

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all of the factors contributing to a successful results achievement on the part of the target person.

See also the examiner's undue experimentation analysis in the rejection set forth below under 35

U.S.C. 112 1<sup>st</sup> paragraph.

In addition, claims 8 and 22 set forth a computer program for achieving the claimed goal of "selecting ... factors reliably contributing to enhance the target people's will to achieve results." A computer program not embodied in a tangible computer medium does not fall within any of the statutory classes of invention.

For the reasons set forth above, the invention set forth in claims 1-22 is not considered to be within any of the statutory classes of invention and therefore is not eligible for patent protection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it does not appear as if the invention could be practiced to produce a concrete result without undue experimentation. The factors set forth for a determination of undue experimentation are set forth in MPEP 2164.01(a), following the analysis in *In re Wands*,

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858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In this case, the intended operation of the invention is to reliably enhance a target person's will to achieve results. The factors used to determine whether the desired change in a target person's will has been achieved and the evaluation means for performing the determination are both subjective in nature (selecting an evaluation value numerically representing responses to sets of questions, etc.), with the result of the process being equally subjective. Applicant has not set forth any evidence that the reference value used as a baseline is a concrete value. Although the baseline number represents the set of answers to questions provided by individuals considered to be successful in achieving the work done that the target person is also engaged in, the fact remains that the baseline is compiled from individuals who are considered to be successful in the judgement of the evaluator. This may not represent the ideal of success for a target person, and for a group of target person's the evaluation criteria established may not be relevant to each individual's desire for success and this cannot be determined without undue experimentation. In addition, Applicant has not set forth any evidence for reliably determining that the factors for enhancing target people's will to achieve results are truly reliable, given the fact that the comparison criteria are derived subjectively, without undue experimentation.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation "the work" in line 9 of the claim, claim 5

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recites the limitation "the work" in line 8 of the claim, and Claim 8 recites the limitation "the work" in line 8 of the claim. There is insufficient antecedent basis for this limitation in the claims.

Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are rejected as they inherit the deficiencies of the independent claim.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "the storage device" in lines 8 and 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonstetter et al (5,551,880).

Regarding claims 1 and 4, Bonstetter et al discloses a selection system comprising an output of questions to targeted users (Col 3, lines 29-35), a processor that receives responses to the questions (Col 3, lines 10-15), calculates a numerical value for the responses (Col 3, lines 15-28), and compares the calculated coefficient to a standard reference value and uses this comparison to predict a personality trait that will achieve success (Col 3, lines 45-56). Bonstetter et al does not specifically disclose that input information represents work done by target individuals. However, Bonstetter teaches a standard measure for comparison is results of persons known to be superior performers for a job, or other selected standard (Col 4, lines 8-11). It is common and well-known that superior performance on a job is an indicator that an individual with superior work performance has accomplished all of the work required for a given work position and serves as a standard of measure against which other individuals may be compared and would provide information with which to perform a comparison. Therefore, it would have been obvious to one of ordinary skill in the art to provide a selection system comprising an output of questions to targeted users, a processor that receives responses to the questions, calculates a numerical value for the responses, and compares the calculated coefficient to a standard reference value as disclosed by Bonstetter and uses this comparison to predict a personality trait that will achieve success wherein input comparison information for correlation



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represents work done by target individuals as taught by Bonstetter for the purposes of selecting individuals who perform work at or above the level achieved by the baseline worker.

Regarding claim 2, Bonnstetter et al discloses a selection system comprising a memory device in which the evaluation values for the question responses are stored (Col 5, lines 29-32).

Regarding claim 3, Bonnstetter et al discloses a selection system that generates a plurality of evaluation values showing tendency to one another, an evaluation vector and that these values are stored in a storage device (Col 5, lines 29-48 and Lookup Table in Col 14).

Regarding claims 5 and 8, Bonnstetter et al discloses a selection system comprising an output of questions to targeted users (Col 3, lines 29-35), a processor that receives responses to the questions (Col 3, lines 10-15), calculates a numerical value for the responses (Col 3, lines 15-28), and compares the calculated coefficient to a standard reference value and uses this comparison to predict a personality trait that will achieve success (Col 3, lines 45-56), and selecting the calculated coefficient where the calculated factor is equal to or greater than a standard reference value used to predict a personality trait that will achieve success (Col 4, lines 1-20 and Lookup Table in Col 14). Bonstetter et al does not specifically disclose that input information represents work done by target individuals. However, Bonstetter teaches a standard measure for comparison is results of persons known to be superior performers for a job, or other selected standard (Col 4, lines 8-11). It is common and well-known that superior performance on a job is an indicator that an individual with superior work performance has accomplished all of the work required for a given work position and serves as a standard of measure against which other individuals may be compared and would provide information with which to perform a comparison. Therefore, it would have been obvious to one of ordinary skill in the art to provide

a selection system comprising an output of questions to targeted users, a processor that receives responses to the questions, calculates a numerical value for the responses, compares the calculated coefficient to a standard reference value, selecting the calculated coefficient where the calculated factor is equal to or greater than a standard reference value used to predict a personality trait that will achieve success as disclosed by Bonstetter, and uses this comparison to predict a personality trait that will achieve success wherein input comparison information for correlation represents work done by target individuals as taught by Bonstetter for the purposes of selecting individuals who perform work at or above the level achieved by the baseline worker.

Regarding claim 6, Bonnstetter et al discloses a selection system that stores the calculated evaluation value corresponding to the responses to questions in memory (Col 5, lines 29-32).

Regarding claim 7, Bonnstetter et al discloses a selection system that generates valuation vectors based on the response to questions, generates a cluster of vectors showing similar tendencies to one another, and stores these vectors in memory (Col 5, lines 29-57).

Regarding claim 9, Bonnstetter et al discloses a processor for determining properties of each of the target people that are related to the selected factors based on an evaluation value numerically representing a response to each of the questions (Col 3, lines 18-28).

Regarding claims 10-12, Bonnstetter et al discloses a determination system comprising reference data that includes a numerical evaluation value for question response (claim 10), a plurality of evaluation values combined to form an evaluation vector (claim 11), and a calculated factor related to a success oriented personality trait (claim 12) (Col 3, lines 18-28, Col 4, lines 8-20, and Lookup Table in Col 14).

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Regarding claims 13 and 14, Bonnstetter et al discloses a determination system in which the properties determined for target people are shown to the target people (claim 13) and an output device which displays the determined properties (claim 14) (Col 2, lines 30-34, and Lookup Table in Col 14).

Regarding claims 15 and 16, Bonnstetter et al discloses a determination system comprising a computerized system for determining personality traits of target people which includes a memory device for storing reference data, a processor for determining properties of each of the target people that are related to the selected factors based on an evaluation value numerically representing a response to each of the questions based on stored reference data (Col 3, lines 40-56).

Regarding claim 17, Bonnstetter et al discloses a method that comprises reference data that includes a numerical evaluation value for question response (Col 10).

Regarding claim 18, Bonnstetter et al discloses a method in which related evaluation vectors numerically representing the responses to questions are stored in a cluster (Col 12).

Regarding claim 19, Bonnstetter et al discloses a method for referring responses to questions from a plurality of respondents in the same group and determining the properties of the group which are related to personality traits that contribute to success (Col 17, lines 35-67).

Regarding claim 20, Bonnstetter et al discloses a method of showing an instruction created in accordance with determined personality traits to the target people (Col 2, lines 30-34).

Regarding claim 21, Bonnstetter et al discloses a method that outputs the determined properties related to personality traits for respondents (Col 3, lines 65-67).

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Regarding claim 22, Bonnstetter et al discloses a program for determining properties related to selected factors, based on an evaluation value numerically representing the response to each of the questions posed of target people (Col 3, lines 18-28), and using the reference dated for determining the properties of the target people (Col 3, lines 37-55).

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Sotomayor whose telephone number is 703-305-4558. The examiner can normally be reached on 6:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4558.

jls  
October 31, 2003

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
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